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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,237	02/20/2001	Werner Blumenstock	Q63062	4413

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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WASHINGTON, DC 20037-3213

EXAMINER

BOUTAH, ALINA A

ART UNIT	PAPER NUMBER
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2143

MAIL DATE	DELIVERY MODE
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10/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	09/785,237	BLUMENSTOCK, WERNER
	Examiner	Art Unit
	Alina N. Boutah	2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 August 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 and 27-35 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-7 and 27-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment filed August 6, 2007. Claims 1-7 and 27-35 are pending in the present application.

Specification

The amendment filed August 6, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly inserted section which further discusses the automation system.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 and 27-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The original specification, discloses the operation of automation system. However, it is unclear as to what the automation system is, i.e. hardware, software, client, server, etc.

Amended claim 4 introduces new matter that was not part of the original disclosure. Therefore these matters will not be considered.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 27-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The specification, discloses the operation of automation system. However, it is still unclear as to what the automation system is, i.e. hardware, software, client, server, etc.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-7 and 27-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,715,393 issued to Naugle in view of USPN 6,003,070 issued to Frantz.

Regarding claim 1, Naugle teaches a system operable to generate a message related to a control unit of an automation system (figure 2: combination of monitor computer and target computer), the system comprising:

a data transmission system (figure 1: network 37) in communication with the control unit (figure 2: monitor computer 11) and in further communication with a receiving device (figure 2: target computer 12),

wherein the message is an e-mail message generated in response to an operation of the automation system and the data transmission system is an Intranet and/or the Internet and the control unit comprises means for generating the message for a specific receiving device addressable with a pre-defined address and wherein further the message has an address field to identify a recipient of the corresponding message, and the receiving device has means to receive the message sent by the control unit and automatically respond to the message (figure 2; abstract; example of status email message on col. 4, line 38 to col. 5, line 22).

However, Naugle does not explicitly teach wherein the control unit monitors and controls operation of the automation system and in response to a fault detected in the automation system, generates the e-mail message, and wherein the automation system comprises equipment of a production or a manufacturing process.

In an analogous art, Franz teaches an interface device that monitors (abstract; col. 2, lines 15-31) and controls operation of the automation system (col. 4, lines 43-51) and in response to a

fault detected in the automation system, generates the e-mail message (abstract; figure 1; col. 2, lines 15-31; col. 4, lines 56-62), and wherein the automation system comprises equipment of a production or a manufacturing process (title, abstract). At the time the invention was made, one of ordinary skill in the art would have been motivated to employ a control unit that monitors and controls an automation system in order to facilitate the network management, thus making the network more robust.

Regarding claim 2, Naugle teaches the system as claimed in claim 1, wherein the message has an identification field for inserting a message identification that is individually assigned to each message and the control unit comprises means to receive an acknowledgment returned by the receiving device which is intended for the control unit, said acknowledgment comprising the identification associated with the message as an acknowledgment identification, and the control unit further comprising means to compare the acknowledgment identification contained in acknowledgment with the message identification contained in the transmitted message (example of status email message on col. 4, line 38 to col. 5, line 22).

Regarding claim 3, Naugle teaches a system as claimed in claim 2, wherein the control unit further comprises means for marking the message as acknowledged if the means to compare determines that the control unit has received an acknowledgment with the message identification assigned to the associated transmitted message (example of status email message on col. 4, line 38 to col. 5, line 22).

Regarding claim 4, Naugle teaches a system as claimed in claim 1, wherein the control unit is a numeric control unit (claim 3, activating remote paging).

Regarding claim 5, Naugle teaches a control unit of an automation system comprising a transmitting device operable to generate and transmit an alarm or fault message of the automation system, via a data transmission system, to a receiving device capable of being linked to said data transmission system, wherein the transmitting device comprises means to generate the message as an e-mail message directed through the data transmission system embodied as an Intranet and/or the Internet, wherein the message comprises an address field to identify a recipient of the corresponding message and wherein the automation system comprises equipment of a production or manufacturing process (figure 2; abstract; col. 1, lines 35-50; example of status email message on col. 4, line 38 to col. 5, line 22).

Regarding claim 6, Naugle teaches a control unit as claimed in claim 5, wherein said control unit is a stored-program control unit (abstract).

Regarding claim 7, Naugle teaches a control unit as claimed in claim 5, wherein the message comprises an identification field for a message identification individually assigned to each message, the control unit further comprising; means to receive an acknowledgment returned by the receiving device to the control unit, said acknowledgment comprising the identification associated with the underlying message as the acknowledgment identification, and means to

compare the identification contained in the acknowledgment with the identification contained in the transmitted message (example of status email message on col. 4, line 38 to col. 5, line 22).

Regarding claim 27, Naugle teaches the system according to claim 1, wherein the acknowledge message provides the control unit with instructions to execute a predetermined action in response to the detected fault (col. 5, lines 23-53).

Regarding claim 28, Naugle teaches the system according to claim 1, wherein the response to the message comprises control commands in a programming language, and wherein said control commands influence at least one operation of the automation system (col. 2, lines 41-57) and wherein the control commands are automatically executed by the control unit (see claim 3 of Naugle).

Regarding claim 29, Naugle does not explicitly teach the system according to claim 1, wherein the automation system comprises a plurality of equipment interrelated in the manufacturing process to produce a product. In an analogous art, Frantz teaches automation system comprising a plurality of equipment interrelated in the manufacturing process to produce a product (col. 2, lines 16-31). At the time the invention was made, one of ordinary skill in the art would have been motivated to employ equipments in the automation system in order to allow the maintenance of remote equipments.

Regarding claim 30, Naugle teaches the system according to claim 1, wherein the control unit receives the response from the receiving device, the status of the e-mail message is automatically changed to acknowledged enabling management of the e-mail message (figure 2: 18-20).

Regarding claim 31, Naugle teaches the system according to claim 1, wherein the e-mail message is an alarm message generated in response to the operation of the automation system when the control unit detects at least one of a fault occurring in the automation system and an attainment of a predetermined threshold to the operation of the automation system (col. 1, lines 29-45).

Regarding claim 32, Naugle teaches the system according to claim 1, wherein the receiving device automatically responds to the message by sending the control unit a reply message and wherein the control unit is a numerical controller (col. 1, lines 35-50 and figure 2: 18-20).

Claim 33 has similar elements as claimed in claims 1 and 5, except if further claims that the method is used to generate a fault and/or alarm message of a stored-program control unit, a numerical control unit and/or a robot control unit in connection with an automation system. This is taught by Frantz in col. 2, lines 16-30.

Claims 34-35 are similar to claims 2 and 3, respectively, therefore a rejected under the same rationale.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

Rejections of claims 1-7 and 27-35 under 35 U.S.C. 112, first and second paragraphs -

In the Office Action dated May 4, 2007, the Examiner has alleged that the specification, while disclosing the operations of the control unit, did not clearly provide an enablement for the automation system as claimed. In an attempt to overcome the rejection, Applicant has amended the specification as well as cited a reference (US Patent No. 6,263,487) to explicitly set forth an exemplary description of an automation system. However, this is considered new matter since it was not part of the original disclosure, therefore it will not be considered.

Rejection of claims 1-7 and 27-35 under 35 U.S.C. 103(a) as being unpatentable over Naugle in view of Frantz.

In response to Applicant's argument that Frantz fails to teach a control unit that monitors and controls operation of the automation system, the Office disagrees and submits that this is indeed taught by Frantz in the cited areas above.

The abstract, for example discloses an interface device that is either integral or peripheral to equipment that requires monitoring and maintenance. The interface in this case is interpreted as a control unit while the equipment is interpreted as automation system as claimed.

Figure 1 illustrates the embodiment of the interface device 10, which includes an interpreter 16. Col. 4, lines 43-51 discloses the functionality of the interpreter. Specifically, it recites "the interpreter converts e-mail from technician into data usable by the equipment. The email from the technician could be system **commands**, requests for information, **upgrade instructions**, and other data used to **repair**, **maintain**, *monitor*, or **upgrade the system**." These instructions clearly imply that the interface device (control unit) controls and monitors the equipment (automation system).

In response to Applicant's argument that Frantz does not disclose or suggest the interface unit being a stored program control unit, a numerical control unit, and/or a robot control unit as cited in claim 33, the Office disagrees and submits that Frantz does teach at least one of the claimed control units. Since none of the mentioned unit is explicitly defined in the original disclosure, the Office reasonably interprets a "stored program" control unit to be a unit that executes a program. In this case, the commands received by the interpreter 16, as discussed in col. 4, lines 43-51 of Frantz, for example, is broadly interpreted as a stored program as claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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